



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,115	02/26/2004	Yohei Katayama	2004_0305A	1839
513	7590	03/16/2005	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			SY, MARIANO ONG	
		ART UNIT	PAPER NUMBER	3683

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/786,115	KATAYAMA ET AL.
	Examiner Mariano Sy	Art Unit 3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5 and 7-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02262004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election of Specie B, fig. 2-7, claims 1-3, 5, and 7-9 in the reply filed on January 11, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The disclosure is objected to because of the following informalities:

page 13, line 13 "wide rage" should be --wide range--,

Claim 3, line 2 "the viscosity variable fluid" should be --the variable viscosity fluid--,

Claim 5, line 2 "the viscosity variable fluid" should be --the variable viscosity fluid--.

Appropriate correction is required.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Brooks (US 6,352,144).

Re-claim 1 Brooks disclosed, as shown in fig. 2-3, a controllable damping force shock absorber comprising: a cylinder in which a variable viscosity fluid is sealably contained; a piston 4; a piston rod 66; and a damping force-controlling mechanism for generating a controlled damping force by controlling a flow of the variable viscosity fluid caused by slidable movement of the piston, the damping force-controlling mechanism including: a damping valve 22 having a pressure-receiving portion for receiving a pressure of the variable viscosity fluid in at least one of an extension stroke and a compression stroke of the piston rod, a pilot chamber 43,143 provided behind the pressure-receiving portion, wherein a pressure in the pilot chamber is applied in a direction for closing the damping valve; a pilot passage 16 for allowing the variable viscosity fluid to flow through the pilot chamber according to slidable movement of the piston; and viscosity-changing means 5 adapted to change viscosity of the fluid flowing through the pilot passage.

Re-claim 2 Brooks disclosed, as shown in fig. 2-3, wherein the pressure-receiving portion includes an extension-stroke pressure-receiving portion for receiving the pressure of the fluid in the extension stroke and a compression-stroke pressure-receiving portion for receiving the pressure of the fluid in the compression stroke.

Re-claims 3 and 5 Brooks disclosed, as shown in fig. 2-3, wherein the variable viscosity fluid is a magnetic fluid and the viscosity-changing means comprises a coil

which generates a magnetic field acting on the magnetic fluid flowing through the pilot passage, see col. 2, lines 19-33.

Re-claim 7 Brooks disclosed, as shown in fig. 2-3, wherein the viscosity-changing means has portions provided in the pilot passage on opposite sides of the pilot chamber.

Re-claim 8 Brooks disclosed, as shown in fig. 2-3, wherein the damping force-controlling mechanism provides reverse damping force characteristics in which when soft damping is generated in one of the extension stroke and the compression stroke, hard damping is generated in the other stroke, see col. 3, lines 17-21.

Re-claim 9 Brooks disclosed, as shown in fig. 2-3, wherein the damping force-controlling mechanism includes a single damping valve and a single pilot chamber.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Muhlenkamp (US 6,260,675)

Koh (US 6,279,702)

Hopkins et al. (US 6,311,810)

Lisenker (US 6,336,535)

Oliver et al. (US 6,419,058)

Oliver et al. (US 6,637,557)

Lun et al. (US 6,612,409)

Lun et al. (US 6,655,511)

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariano Sy whose telephone number is 703-308-3427. The examiner can normally be reached on Mon.-Fri. from 9:00 A.M. to 3:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Sy M. Sy

March 7, 2005

M. C. Graham
3/10/2005
MATTHEW C. GRAHAM
PRIMARY EXAMINER
GROUP 310